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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,640	11/26/2001	Robert Kuhlmann	209833US0	4060

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER


JOHNSON, EDWARD M

ART UNIT PAPER NUMBER

1754

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/991,640	Applicant(s) KUHLMANN ET AL. 	
	Examiner Edward M. Johnson	Art Unit 1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

The allowability of claims 5-9 has also been withdrawn due to the discovery of a disclosed value of about 42 g/l solids content within the cited reference.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed DBP range includes all points above 380, including all those above 420, which does not appear to be supported by the original disclosure. However, Applicant is

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invited to point out where in the disclosure such support may be found.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nauroth et al. US 4,495,167.

Regarding claims 1 and 18, Nauroth '167 discloses precipitated silica having a surface area of 400-600 m²/g, pH of 6-7, DBP number of 340-380%, density of 180-220 g/l, and ALPINE sieve residue >63 microns of 25-60 (see abstract).

Regarding claims 2-4, Nauroth '167 discloses precipitated silica having a surface area of 400-600 m²/g, pH of 6-7, DBP number of 340-380%, density of 180-220 or 75-120 g/l, and ALPINE sieve residue >63 microns of 25-60 or 0.1 (see abstract).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 10-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nauroth '167.

Regarding claims 10-17, Nauroth '167 discloses precipitated silica comprising a surface area of 400-600 m²/g, pH of 6-7, DBP number of 340-380%, density of 180-220 or 75-120 g/l, and ALPINE sieve residue >63 microns of 25-60 or 0.1 (see abstract).

In the event any differences can be shown for the product of the product-by-process claims 10-17, as opposed to the product/process taught by Nauroth '167, such differences would have been obvious to one of ordinary skill in the art at the time the invention was made as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (Fed.Cir. 1985).

8. Claims 5-9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nauroth '167.

Regarding claims 5-9, Nauroth '167 discloses precipitated silica comprising a surface area of 400-600 m²/g, pH of 6-7, DBP

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number of 340-380%, density of 180-220 or 75-120 g/l, and ALPINE sieve residue >63 microns of 25-60 or 0.1 (see abstract).

Nauroth '167 fails to disclose a solids content of 36-42 g/l.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain a solids content of 36-42 g/l because Nauroth discloses 46 g/l (Example 1) and about 46 g/l (see claim 4), which would obviously, to one of ordinary skill, suggest a range of acceptable values at least including 42 g/l.

Regarding claim 18, Nauroth '167 fails to disclose a DBP of greater than 380 g/l.

It is considered that a DBP of greater than 380 g/l would have been obvious to one of ordinary skill in the art at the time the invention was made because Nauroth discloses DBP values of up to 380, which would obviously, to one of ordinary skill, include at least some infinitesimal values above 380 with a reasonable expectation of achieving a similarly favorable result as that within the disclosed range.

Response to Arguments

9. Applicant's arguments filed 12/9/03 have been fully considered but they are not persuasive.

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The rejection under 35 USC 112(2) has been withdrawn in view of Applicant's amendment.

It is argued that the rejections of Claims 1-4... are respectfully traversed. This is not persuasive because Applicant appears to admit that the claimed product features are disclosed, merely alleging novelty of the instantly claimed process of making. Further, it is unclear which of Applicant's representations to the Office is correct; the representation made in the cited patent, or the one made here in the instant Application, both of which are commonly assigned. This appears to be insufficient to establish patentability of the instant claims, as it is merely based on Applicant's own contradictory representations to the Office, the earlier of which resulted in apparently expired patent claims to similar subject matter.

It is argued that as the table shows... lower silica concentration. This is not persuasive because Applicant asserts that the claimed DPB absorption value is "neither disclosed nor suggested" while at the same time admitting that such value is disclosed in the cited reference (see Remarks and Applicant's amendment to the instant specification).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the

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receptionist whose telephone number is 571-272-0987.

EMJ

A handwritten signature in cursive script, appearing to read "Ellen M. [unclear]".